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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,506	08/06/2001	Marta Blumenfeld	50.US3.PCT	9451

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GENSET
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EXAMINER

GUNTER, DAVID R

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,506

Applicant(s)

BLUMENFELD ET AL.

Examiner

Daivd Gunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8,11,13-15,19,23-25,28,35-37,39,47,48,51 and 57 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claim(s) 1-5,8,11,13-15,19,23-25,28,35-37,39,47,48,51 and 57 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Status of the Application

1. The examiner acknowledges the applicant's cancellation of Claims 6, 7, 9, 10, 12, 16-18, 20-22, 26, 27, 29-34, 38, 40-46, 49-50, and 52-56 in the preliminary amendment dated April 13, 2001.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1. The claims lack unity because they are drawn to a large number of distinct polynucleotides, each of which constitutes a separate special technical feature. Furthermore, the sequences lack a special technical feature because the prior art teaches other polynucleotide sequences that are isolated from the CNS and that are associated with schizophrenia.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, Claims 1-5, 8, 11, 13-15, 19, and 23-25, drawn to an isolated, purified polynucleotide, classified in class 536, subclass 22.1 .

Group II, Claims 28, 35-37, 39, 47, 48, and 57, drawn to a method of genotyping, classified in class 436, subclass 94.

Group III, Claim 51, drawn to a computer readable medium, classified in class 360, subclass 135.

3. Group I is related to Groups II and III as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using

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the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of Group I have a plurality of potential uses other than those of Groups II and III including acting as a template for amplification, acting as probes in Southern blotting, or identifying DNA binding proteins.

4. Groups II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). The comparison of the sequence of DNA derived from a patient sample to the wild-type sequence as recited in Group II requires the use of a computer readable medium on which the nucleic acid sequences have been encoded. This computer readable medium, however, can be used in a plurality of processes materially different from the analysis of Group II including searching the nucleic acid sequence for known motifs, predicting potential peptides encoded by the nucleic acid, etc.

Restriction Requirement Applicable to All Groups

In addition, each group detailed above reads on a large number of distinct polynucleotides, each of which constitutes a separate special technical feature. Furthermore, the sequences lack a special technical feature because the prior art teaches other polynucleotide sequences that are isolated from the CNS and that are associated with schizophrenia. The

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application specifically recites claims drawn to SEQ ID NOs: 1, 2, 3, 4, 6, and 31-39. These sequences may contain a G713 or 13q31-q33-related biallelic marker selected from the group consisting of A1 to A49. Additional claims are drawn to nucleic acids that encode the protein sequences of SEQ ID NOs: 5 and 7. Still further claims are drawn to polynucleotides consisting essentially of sequences B1-B49, C1-C49, D1-D49, E1-E49, and P1-P49.

Polynucleotides with different sequences are structurally distinct chemical compounds and are unrelated to one another. Each of these sequences are thus deemed to normally constitute a distinct special technical feature and are therefore subject to a restriction requirement.

The applicants are restricted to a single nucleotide sequence identified by a Sequence ID Number. This nucleotide sequence must be clearly defined, with each residue specified without ambiguity. The applicant may choose to define the selected nucleotide sequence as a nucleotide sequence that encodes a specified polypeptide sequence. Applicant should note that although defining the nucleotide sequence in these terms is based on the selection of an amino acid sequence, it is the corresponding nucleotide sequence that will be prosecuted on its merits.

The applicant should be aware that selection of a single SEQ ID NO: represents a response to a restriction requirement, not an election of species.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David R. Gunter whose telephone number is (703) 308-1701. The examiner can normally be reached on 9:00 - 5:00 M - F.

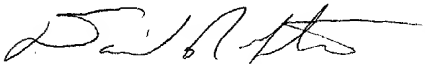
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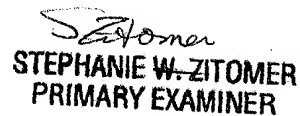
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-9212 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0198.



David R. Gunter, DVM, PhD
September 30, 2002



STEPHANIE W. ZITOMER
PRIMARY EXAMINER